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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,784	09/17/2003	Terry Earl Kelley		4832

7590

06/01/2004

Mr. Terry Earl Kelley
2738 MLK JR Way
Berkeley, CA 94703

EXAMINER

DANG, HOANG C

ART UNIT PAPER NUMBER

3672

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,784

Applicant(s)

KELLEY, TERRY EARL

Examiner

Hoang Dang

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-4, 14-17, 19-21, 32-34, 36, 38-40, 50-53; 55-57, 67-69 and 71 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following recitations in the claims have no support in the original specification and are considered as new matter:

- "all incoming liquid hydrocarbons are efficiently and completely removed from the wellbore..." (claim 2, lines 3-6);
- "a surface gas flow meter for continually and comparatively measuring and monitoring the formation gas flow production, pressure and recovery for the most effective optimum gas flow pressure at the surface and periodically making and observing fluid level and gas-oil ratio test, while continually and comparatively measuring and monitoring the production and recovery of formation liquids through a surface metering facility for a combined total maximum gaseous and liquid hydrocarbon production and ultimate recovery, throughout the reservoir's formations total gaseous and liquid hydrocarbon recovery life for maximum hydrocarbon reserve value (claim 3);

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- "the surface gas flow pressure regulator and the surface pressure gas gauge for continually and controllably and comparatively regulating flowing formation gas production and pressure at a controlled flow pressure... wherein total in place liquid hydrocarbons are maintained highly fluid and recoverable" (claim 4);
- "the surface gas flow pressure regulator for closing off the wellbore annulus at the well head exit port throughout the complete production and total recovery of all in place liquid hydrocarbons until said production and recovery considerably declines, at such time converting over to total gas production by releasing the surface gas flow pressure to a full opened gas flow pressure at the surface gas flow regulator to efficiently produce and recover natural gas, whereby total in place liquid hydrocarbons have been recovered, leaving only the small quantities that stick to the formation rock pores as a thin film, and that are isolated in any formation structural traps, wherein in place gas is free to flow to the surface for total in place natural gas production and ultimate recovery, thereby recovering total in place liquid and gaseous hydrocarbons maintained and converted by this recovery process to be ultimately recoverable" (claims 14 and similar language in claims 16 and 17);
- "such that the upper gas zone is assisted by maintained overhead pressure for the production and recovery of all incoming liquid hydrocarbonsformation, whereby early total in place liquid hydrocarbon recovery is economically realized at low cost, wherein total in place gaseous and liquid hydrocarbon reserve value is significantly increased by becoming recoverable" (claim 15, lines 7-16);

- "by complete removal of liquids from the wellbore" (claim 37, line 3 and claim 54, line 3);

It is noted that applicant is required to correct the same in claims 19, 20, 21, 32, 33, 34, 36, 38, 39, 40, 50, 51, 52, 53; 55, 56, 57, 67, 68, 69 and 71 because:

claims 19, 38 and 55 are substantially identical to claim 2;
claims 20, 39 and 56 are substantially identical to claim 3;
claims 21, 40 and 57 are substantially identical to claim 4;
claims 32, 50 and 67 are substantially identical to claim 14;
claims 33, 51, and 68 are substantially identical to claim 15;
claims 34, 52 and 69 are substantially identical to claim 16; and
claims 36, 53 and 71 are substantially identical to claim 17.

Claim Objections

3. Claims 15, 33, 51 and 68 are objected to because of the following informalities: the expression "such as to prevent surface gas flaring" in claim 15, line 3, claim 33, line 4, claim 51, line 4 and claim 68, line 5 make the claims indefinite since it is not clear whether the phrase following the words "such as" is a limitation of the claims. The word "baring" in claim 37, lines 2 and 4, claim 48, line 4, claim 51, line 3, claim 54, lines 2 and 4, claim 55, line 3, claim 65, line 4 and claim 68, line 3 should be --bearing--. Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-71 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,622,791. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a downhole pump in the production tubing is well known in the art to assist in lifting formation fluids to the surface.

Priority

6. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

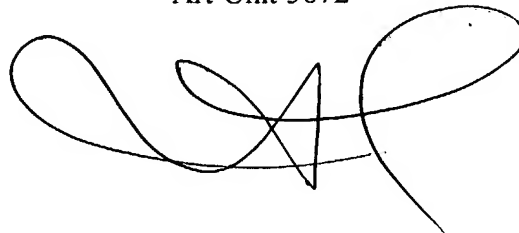
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 703-308-2149. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang
Primary Examiner
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A handwritten signature in black ink, consisting of a large, stylized 'H' followed by a series of loops and a long horizontal stroke extending to the right.

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5/25/2004